Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH S. KNAPTON III

Appeal No. 2000-2227
Application No. 09/089,834

ON BRIEF

Before KRASS, JERRY SMITH, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

A patent examiner rejected claims 1-5 and 12-17 under 35 U.S.C. § 112, ¶ 2, as indefinite; claims 1-6, 8, 12-13, and 15-17 under 35 U.S.C. § 102(e) as anticipated; and claims 7 and 14 under 35 U.S.C. § 103(a) as obvious. The appellant appealed therefrom. We affirmed the rejection of claims 1-5 and 12-17 under § 112, ¶ 2; the rejection of claims 6 and 8 under § 102(e); and the rejection of claim 7 under § 103(a). *Ex parte Knapton*, No. 2000-2227, at 9 (Bd.Pat.App. & Int. July 18, 2002). In addition, we reversed the rejection of claims 1-5, 12-13, and 15-17 under § 102(e) and the rejection of claim 14 under § 103(a). *Id.*

The appellant asks that we reconsider our decision to affirm the rejection of claims 1-5 and 12-17 under § 112, ¶ 2. A brief history of that rejection follows. The examiner introduced the indefiniteness rejection in his First Action on the Merits ("FAOM"), asserting, "[w]ith respect to claim 1, in line 4, 'inserting a second object' is unclear as to where the second object is being inserted. Claim 12 is rejected for the same reason as claim 1." (Paper No. 4 at 10.) Although the appellant contested other rejections in his reply to the FAOM, (Paper No. 5 at 2-3), he was silent regarding the indefiniteness rejection. Referencing the FAOM, the examiner maintained the indefiniteness rejection in his Final Rejection. (Paper No. 6 at 2.) Although the appellant contested other rejections in his reply to the Final Rejection, (Paper No. 5 at 1-4), he remained silent regarding the indefiniteness rejection. In his Appeal Brief, the appellant acknowledged the indefiniteness rejection, (Paper No. 10 at 1 ("claims 1-8 and 12-17 are rejected under [] **§ 112**")), but did not contest it. The examiner repeated the indefiniteness rejection *in toto* in his Examiner's Answer. (Paper No. 11 at 3.) Although the appellant contested other rejections in his Reply Brief, (Paper No. 12 at 1-3), he resumed his silence regarding the indefiniteness rejection.

In summary, although the appellant acknowledged the indefiniteness rejection, he elected not to contest it. Noting the maxim that "'[s]ilence implies assent,'" *Knapton*, at 4 (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 572, 225 USPQ 1073, 1085 (1985)), and not being persuaded that the examiner erred in rejecting the claims as indefinite, we affirmed *pro forma* the rejection of claims 1-5 and 12-17 under 35 U.S.C. § 112, ¶ 2 . *Knapton*, at 4 .

The appellant now argues that, under Manual of Patent Examining Procedure ("M.P.E.P." or "Manual") § 1206, his election not to contest the indefiniteness rejection made his appeal brief defective and that the examiner should have notified the appellant of the alleged defect and given him the opportunity to file another brief. (Req. Reh'g at 1.) Accordingly, the appellant "requests the Board to withdraw its decision and remand the matter to the Examiner to correct the brief." (*Id.* at 2.)

The United States Patent and Trademark Office "conducts its proceedings in accordance with regulations set out in Title 37 of the Code of Federal Regulations," *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988), and in accordance with procedures set out in M.P.E.P. *Id.*, 7 USPQ2d at 1154. Title 37 does not require an appellant to appeal or contest each outstanding rejection; an

appeal need only be taken from those rejections "which the applicant or patent owner proposes to contest." 37 C.F.R. § 1.191(c)(2002). Similarly, the appellant's brief need set forth **only** those "authorities and arguments on which appellant will rely to maintain the appeal." *Id.* at § 1.192(a). Of course, "[a]ny arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." *Id.*

For its part, the Manual "'does not have the force of law or the force of the Patent Rules of Practice (37 CFR).'" *Racing Strollers Inc. v. TRI Indus. Inc.*, 878 F2d 1418, 1421-22, 11 USPQ2d 1300, 1303 (Fed. Cir. 1989) (quoting the M.P.E.P.'s Forward). *See also Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988) ("The MPEP states that it is a reference work on patent practices and procedures and does not have the force of law. . . .") To the extent that the M.P.E.P. conflicts with Title 37, therefore, the latter controls. The Manual need not be viewed, however, as requiring that each ground of rejection be appealed or contested. To the contrary, M.P.E.P. § 1206 (8th ed., August, 2001) only states that "[a]n appellant's brief must be responsive to every ground of rejection stated by the examiner." We hold that the mere acknowledgment of a ground of rejection satisfies the § 1206's need for responsiveness.

Here, the appellant's acknowledgment of the rejection of claims 1-5 and 12-17 under 35 U.S.C. § 112, ¶ 2, (Appeal Br. at 1), was sufficiently responsive to that ground of rejection. Furthermore, we find no indication that the appellant chose to appeal the indefiniteness rejection. To the contrary, although he had at least four opportunities to contest the rejection (viz., his reply to the FAOM, his reply to the Final Rejection, his Appeal Brief, and his Reply Brief), the appellant elected not to do so. The appellant fails to show that his election constituted a defect in his appeal brief or that the examiner was required to "notify," i.e., remind, the appellant of his own election or to give him the opportunity to file another brief. Therefore, we deny the appellant's request to withdraw our decision and remand the matter to the Examiner.

We have granted the appellant's request to the extent that we have reconsidered our original decision, but we deny the request with respect to making any changes therein. As we noted in our original decision, our affirmances are based only on the arguments made in the briefs. Arguments not made therein are neither before us nor at issue but are considered waived. 37 C.F.R. § 1.192(a). No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

TIMOTHY N. TROP
TROP, PRUNER & HU, P.C.
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024